

## **REMARKS**

Claims 21-38 are currently pending in the application. By this amendment, claims 21, 25 and 36 are amended for the Examiner's consideration. Claims 37 and 38 are added. The above amendments and added claims do not add new matter to the application and are fully supported by the specification. For example, support for the amendments is provided at Figures 13 and at pages 3, 5-7, and 13-14 of the specification. Support for the added claims is provided in the specification and the original claims. Reconsideration of the rejected claims in view of the above amendments and the following remarks is respectfully requested.

### ***Allowed Claims***

Applicants appreciate the indication that claim 33 contains allowable subject matter. In view of the comments below, Applicants submit that the 35 U.S.C. §112, 2nd paragraph of claim 33 be withdrawn and that claim 33 be indicated as allowed. Applicants also submit that all of the claims are in condition for allowance for the reasons set forth below.

### ***35 U.S.C. §112 Rejection***

Claims 33 was rejected under 35 U.S.C. §112, 2<sup>nd</sup> paragraph. This rejection is respectfully traversed.

The Examiner asserts that claim 33 is indefinite because the "flow of the claim language suggests that the writing steps and the read steps occur after the display steps, thus rendering the writing and reading moot. Therefore it remains unclear when exactly the writing and reading steps should take place" (Office Action, paragraph 3). Applicants disagree with the Examiner's assertion that the order of the clauses in claim 33 renders the claim indefinite.

Applicants submit that it is improper for the Examiner to read a specific order of the steps into the method of claim 33. MPEP §2111.01 states that

...it was improper to read a specific order of steps into method claims where, as a matter of logic or grammar, the language of the method claims did not impose a specific order on the performance of the method steps, and the specification did not directly or implicitly require a particular order. *Altiris Inc. v. Symantec Corp.*, 318 F.3d 1363, 1371, 65 USPQ2d 1865, 1869-70 (Fed. Cir. 2003).

Moreover, the Examiner is reminded that definiteness of claim language must be analyzed, not in a vacuum, but in light of: the content of the particular application disclosure; the teachings of the prior art; and the claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made. MPEP §2173.02.

Applicants respectfully submit that claim 33 is clear and definite when read in light of the disclosure (e.g., pages 13-15 of the specification and FIGS. 13 and 14). For example, page 13, lines 19-29 disclose:

A preferred method of selecting summary frames from the set .... is to interleave the section of the frames. If at each set of embedding, it is desired to select and embed some M frames ...., the set of summary frames are listed or written into a table 50 of width L/M and height M in a row-wise fashion (i.e., place the frames in the first row, from left to right, then in the second row, and so on), as shown by write arrow 52. ... At each step of the embedding, the frames are read off in a next column, as illustrated by read arrow 54. In this manner, we guarantee that each set of M summary frames selected represent video content spanning a longer period of time than mere[ly] the most recent M summary.

Accordingly, Applicants respectfully request that the rejection over claim 33 be withdrawn.

#### **35 U.S.C. §103 Rejections**

Claims 21, 23-24, 30, 32, and 34-35 were rejected under 35 U.S.C. §103(a) for being unpatentable over U. S. Patent No. 6,732,369 issued to Schein et. al. ("Schein"). Claims 22, 25-29, 31, and 36 were rejected under 35 U.S.C. §103(a) for being

unpatentable over Schein in view of U. S. Patent No. 5,815,145 issued to Matthews, III ("Matthews"). These rejections are respectfully traversed.

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP §2142. Applicants submit that the references supplied by the Examiner do not teach or suggest every feature of the claimed invention.

Claims 21, 23, and 24 in view of Schein

The instant invention is generally related to placing summary frames in a video and, more particularly, to a system for placing summary frames in a currently playing video depicting either past or future scenes of the video so that a viewer can get a quick overview of the video. By way of non-limiting example, implementations of the invention provide a system and method whereby when a channel surfer (e.g., a viewer that is frequently changing channels) arrives at a new channel, rather than only having what is currently playing to catch the eye, summary frames are also available to catch the surfer's attention and aid in understanding the programming. Specifically, independent claim 21 recites, in pertinent part:

... at least one summary frame also displayed on said display screen overlaid onto said video program in progress at a same time when said programming channel is changed, said at least one summary frame comprising a past frame from said video program in progress.

Schein does not teach or suggest these features.

In Schein, as shown in FIG. 16A, the currently tuned program screen 526 and the preview window 528 are separated from one another. That is, the preview window 528 is not overlaid onto the currently tuned program screen 526. In FIG. 17B, on the other

hand, the system shows overlaying a screen with a same scene as the viewing screen. Simply, the screens of FIG. 1B cannot be considered a summary frame and a display screen.

Also it is brought to the Examiner's attention that FIGS. 16A and 17A-17B are directed to different embodiments, which cannot be combined to teach the claimed invention. This would be improper, since Schein does not teach the combination of such features, nor is there any suggestion of such combination. Making such a combination would be akin to picking and choosing from a parts bin which clearly is improper. This would amount to piece meal reconstruction of the claimed invention.

Claims 23 and 24 depend from allowable independent claim 21, and are allowable for at least the reasons discussed above. Moreover, Schein does not teach or suggest many of the features of claims 23 and 24. For example, Schein does not teach or suggest a plurality of summary frames each corresponding to a past frame from the video program in progress, as recited in claim 23.

Claims 30, 32, 34, and 35 in view of Schein

Independent claim 30 recites, in pertinent part:

... selecting a plurality of summary frames depicting selected events from said video program;  
embedding said summary frames in said video program;  
transmitting said video program comprising said summary frames over a media; and  
displaying said video program and said summary frames on a screen at a same time with said video program when a viewer changes to said video program.

Schein does not teach or suggest these features.

The Examiner asserts that Schein discloses selecting a plurality of summary frames, embedding the plurality of summary frames in a window of the video program, and displaying the video program and summary frames on a screen at the same time (Office Action, page 5). Applicants respectfully disagree.

As shown in Schein, only one summary screen 528 is displayed at a single time. There simply is no disclosure, whatsoever, of a plurality of summary frames being shown at the same time as the video programming. Also, even assuming *arguendo* that the summary frame 528 shows a video which is comprised of several frames, Applicants still submit that only one of the summary frames is shown at a time. Thus, even using the interpretation of the Examiner, which Applicants do not agree, Schein still would not display a video program and plurality summary frames on a screen at a same time with the video program.

Additionally, the Examiner is also using two distinct embodiments in this portion of the rejection, FIG. 16 and FIGS. 17B, 17C. As argued above, this is simply not proper since there is no suggestion in Schein to make such a combination. Also, even if such a combination were made, the combination would not result in the claimed invention. For example, FIGS. 17A-17C do not show a summary screen. In FIG. 17C, the inset screen is the same as the viewing screen.

Claims 32, 34 and 35 depend from allowable independent claim 30, and are allowable for at least the reasons discussed above. Accordingly, Applicants respectfully request that the rejection over claims 30, 32, and 34-35 be withdrawn.

In view of the above arguments, Applicants submit that the rejection of claims 21, 23-24, 30, 32, and 34-35 be withdrawn.

Claims 22, 25-29, 31, and 36 in view of Schein and Matthews

Independent claim 25 recites, in pertinent part:

... at least one summary frame displayed on said display screen at a same time and overlaid with said video program when a programming channel is changed ...

Independent claim 36 recites, in pertinent part:

... at least one preview frame comprising a future frame from said video program in progress displayed at a same time as said at least one summary frame and said video program in progress ...

Applicants respectfully submit that Schein and Matthews do not teach or suggest these features.

As discussed above, Schein does not teach or suggest overlaying the video program with at least one summary frame. Instead, FIG. 16 shows two separate screens, and FIGS. 17A-17C are directed to an embodiment where a screen is overlaid on a main screen; however, the screen and main screen have a same scene. There is no disclosure, whatsoever, that a summary frame is overlaid with the video program when a programming channel is changed.

As to claim 36, Schein does not teach a preview frame with a future frame displayed at a same time as a summary frame and the video program in progress. Instead, FIG. 16 only shows two displays: a currently tuned program screen 526 and the preview window 528. These displays or windows are separated from one another, not overlaid. Thus, there simply is no disclosure to have three displays at a single time.

Applicants submit that Matthews does not compensate for the deficiencies of Schein. By example, Matthews, in FIG. 4, shows different screens 104, each of which are representative of a different channel. Accordingly, after a fair reading of Matthews, one of skill in the art would conclude that the different screens 104 are not a preview frame or a future frame, as defined by the claimed invention. Also, as clearly shown in FIG. 4, the screens 104 are not overlaid with one another. Instead, the screens are positioned side by side. Thus, Matthews does not show any of the missing features of claims 25 and 26 (in addition to claim 22).

Accordingly, Applicants respectfully request that the rejection over claims 22, 25-29, 31, and 36 be withdrawn.

#### ***Added Claims***

Claims 37 and 38 have been added to further define the invention and are believed to be patentably distinct from the applied art and in condition for allowance.

**CONCLUSION**

In view of the foregoing amendments and remarks, Applicants submit that all of the claims are patentably distinct from the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue. The Examiner is invited to contact the undersigned at the telephone number listed below, if needed. Applicants hereby make a written conditional petition for extension of time, if required. Please charge any deficiencies in fees and credit any overpayment of fees to Attorney's Deposit Account No. 50-0510.

Respectfully submitted,  
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